

REMARKS

Claims 31, 43, 46, 49-54, 58, 60, 61 and 63-73 were pending in this application.

Claims 31 and 46 are currently amended to clarify what the proviso phrase is meant to exclude. Additionally, claims 31 and 46 are amended to delete the phrase "wherein the nitrogen atom can be quaternized".

No new matter is added.

Claims 31, 43, 46, 49-54, 58, 60, 61 and 63-73 are presented for reconsideration.

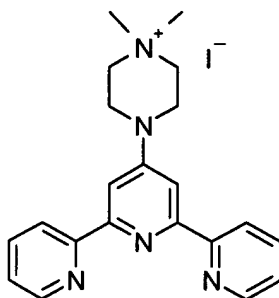
Claim Rejection – 35 USC 102(e)

Claims 31, 43, 46, 49-54, 58, 60, 61 and 63-73 are rejected under 35 USC 102(e) as being anticipated by commonly assigned WO 02/088289.

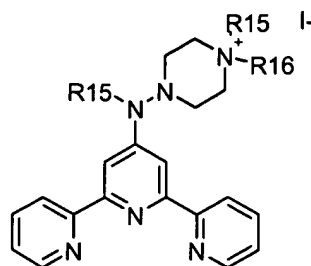
The instant application pertains to the use of certain metal complexes which have terpyridine ligands that contain at least one quaternized nitrogen atom not bonded to one of the three pyridine rings as oxidation catalysts while WO 2002/088289 pertains to the use of certain metal complexes which have terpyridine ligands as oxidation catalysts.

Claims 31 and 46 are currently amended to clarify what the proviso phrase is meant to exclude. Additionally, claims 31 and 46 are amended to delete the phrase "wherein the nitrogen atom can be quaternized".

The instant claims are currently amended to delete any quaternized nitrogen atom that is directly bonded to one of the three pyridine rings. Hence, the instant invention pertains to metal complexes which have terpyridine ligands that contain at least one quaternized nitrogen atom not bonded to one of the three pyridine rings as oxidation catalysts. Therefore, a clear line of demarcation exists between the present application and WO 02/088289. Additionally, the proviso phrases in claims 31 and 46 address any anticipation between WO 2002/088289 Example 8b and the instant invention.

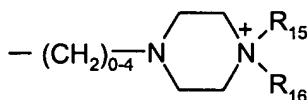


Example 8b of
WO 2002/088289



Instant Compound of
Formula (3)

In the closest analogy of WO 2002/088289 Example 8b and the instant invention, Formula (3) R'_6 is a group $-NR_{14}R_{15}$, Y is iodide, R'_3 and R'_9 are hydrogen.



When the group R_{14} is the radical $-(CH_2)_{0-4}-N^+(R_{15})(R_{16})$ and there is no alkylene ($CH_2 = 0$), a direct bond results which corresponds to the compound shown above.

Therefore, the instant invention is not anticipated by WO 02/088289.

The present 35 USC 102(e) rejection is addressed and is overcome.

Common Ownership

The Examiner rejects the instant invention under 35 USC 102(e) as being anticipated by WO 2002/088289. The US National Stage Application of WO 2002/088289 is US Serial No. 10/476,043, now US 7,161,005. A divisional application of 10/476,043 was filed with the USPTO and is designated 11/497,444, pending.

The presently claimed invention and US 7,161,005 and US Serial No. 11/497,444 were, at the time the invention was made, entirely assigned to Ciba Specialty Chemicals Corporation.

The assignment of US 7,161,005 was recorded in the USPTO August 3, 2006, reel/frame 018145/0820.

The assignment of the instant application was recorded in the USPTO September 11, 2006, reel/frame 018281/0019.

The assignment of US Serial No. 11/497,444 was recorded in the USPTO August 3, 2006, reel/frame 018145/0820.

Accordingly, the instant application and US 7,161,005 and US Serial No. 11/497,444 are commonly assigned to Ciba Specialty Chemicals Corporation.

Provisional Claim Rejections – Nonstatutory Double Patenting

Claim 31 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-8 of copending application number 11/497,444. The office action stated that this application number was 10/497,444 which is not a copending application. This matter was clarified by the Examiner where, in a phone call, he stated the provisional rejection is over 11/497,444.

A terminal disclaimer over U.S. Application No. 11/497,444 according to 37 CFR 1.321(c) is filed herewith.

Claims 31 and 43 provisionally are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of copending application number 10/533,031.

A terminal disclaimer over U.S. Application No. 10/533,031 according to 37 CFR 1.321(d) is filed herewith.

Claim Rejections – Nonstatutory Double Patenting

Claims 46, 49-54, 58, 60, 61, and 63-73 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of US 7,161,005.

A terminal disclaimer over US 7,161,005 according to 37 CFR 1.321(c) is filed herewith.

The Examiner is kindly requested to reconsider and to withdraw the present rejections.

Applicants submit that the present claims are in condition for allowance and respectfully request that they be found allowable.

Respectfully submitted,



for

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